

### REMARKS

Applicants acknowledge receipt of the Office Action dated April 6, 2007, in which the Examiner entered a Restriction Requirement for original Claims 1-48. The Restriction Groups were set out as follows:

**Group I.** Claims 1-18 drawn to a catalyst;

**Group II.** Claims 19-32 drawn to a method for making a catalyst;

**Group III.** Claims 33-45 drawn to a process for making synthesis gas; and

**Group IV.** Claims 46-48 drawn to a process for making middle distillates.

### Status of the Claims

By this reply, Claims 2-17, 22, 34-35, 37-40, 42-43 & 46-48 are now canceled. Claims 1, 19, 21, 23, 24, 26, 31 & 33 have been amended. Claims 49-76 are new. No new matter was added by way of claim amendments and new claims. The support for these claim amendments and new claims are explained in the Amendment to the Claims and New Claims sections below.

As a result of this reply, **Claims 1, 19-21, 23-33, 36, 41, 44, 45 & 49-76 are now pending.**

### Election with Traverse

In this response, Applicants elect Group II (identified as Claims 19-32 by the Examiner) *with traverse*. Applicants reserve the right to prosecute the non-elected claims of Group I (i.e., identified as original Claims 1-18), of Group III (i.e., identified as original Claims 33-45) and of Group IV (i.e., identified as original Claims 46-48) by filing one or more divisional applications.

Applicants canceled Claim 22 and added a total number of 28 claims in this Response (i.e., Claims 49-76) to cover additional embodiments of the elected Group II to which Applicants are entitled. Claims 49-55 are ultimately dependent from Claim 19 of Group II. Furthermore, Applicants added two new independent claims 56 and 70 both drawn to methods for making a catalyst and their respective dependent claims 57-69 & 71-76. Support for these new claims is shown below under the New Claims section.

**Applicants respectfully request that Claims 49-76 be prosecuted in the present application with the elected invention II, and that the elected invention II be redrawn to include Claims 19-21, 23-32 and 49-76.**

In addition, Applicants have cancelled non-elected Claims 2-17, 34-35, 37-40, 42-43 & 46-48 (of non-elected Group I, III and IV) without prejudice in order to make room for the new Claims 49-76. It should be noted that any of these canceled claims from non-elected inventions I, III and IV may be reintroduced later as new claims in the event that any of the inventions I, III and IV is rejoined by the Office to the examination of the present application.

Pending non-elected Claims 1, 33, 36, 41, 44 & 45 will most likely be withdrawn by the Examiner as a result of the Applicants' election. As such, Claims 36, 41, 45 of non-elected invention III which *have not been amended* are identified as 'withdrawn' in the present listing of the claims, and Claim 1, 33 and 44 of non-elected inventions I and III which *have been amended* are also identified as "withdrawn" in accordance to the Revised Amendment Practice in 37 CFR 1.121 in a final rule that became effective July 30, 2003. Indeed, 37 CFR 1.121(c) sets forth that "Withdrawn" is a proper status identifier for a withdrawn claim that is currently amended.

The reasons advanced by Applicants for the traversal of the Restriction Requirement are explained as follows.

No serious burden in search and examination

The Office Action asserts that inventions I to IV are distinct from each other. However, because of the related nature of inventions I to IV (catalyst. method of making such catalyst, and its use), Applicants respectfully disagree with the restriction, for no undue burden of search exists on the Patent and Trademark Office as required by MPEP § 803 to examine claims to all inventions I to IV in the present application.

Delay in restriction is prejudicial to timely examination and patent term of the non-elected inventions.

In addition to the lack of undue burden of search, Applicants further disagree with the restriction due to its tardiness. **The Restriction Requirement dated April 6, 2007 was the first notification to Applicants under 35 U.S.C. § 132 in the examination of the present application, and it was mailed more than three (3) years after its filing date under 35 U.S.C. § 111(a).** Applicants did not bring about such delay, as the fee for the examination of the 48 original claims was timely paid, and there were no actions by the Applicants which resulted in delaying the examination.

As a result of the PTO undue delay in restricting the present case, **Applicants did not have a reasonable opportunity to file a divisional application claiming priority from the present application which has been pending for more than 40 months.** The USPTO delay in the present application causes *de facto* a delay in the examination of any divisional application that may be filed. Moreover, it is believed that such undue delay will have a negative impact on the patent term of any patent granted from the divisional application. In this case, the patent term of a patent that may be granted from the divisional application of the present application would be shortened without merit to less than 17 years, even with expeditious processing of the divisional application(s).

Although a patent granted from the divisional application (whose term ends twenty years from the 35 U.S.C. § 111(a) filing date of the parent application) can have its term *adjusted based on delays during its own examination* under 37 CFR 1.702, **it is believed that there is no provision in the Patent Laws, Rules and Practice for a patent granted from the divisional application to benefit from extension of term because the Office failed to make a timely restriction requirement in the parent application within fourteen months of its filing date.** That is to say, the Office's undue delay of more than 26 months (from the 14-month period after filing of the parent application to the Restriction Requirement date) is not carried over to adjust the term of any patent that would be granted from a divisional application filed after this Restriction Requirement. As such, **Applicants are provided with no recourse to recover this PTO delay by request of an extension of patent term for any patent resulting from a divisional application.**

Thus, Applicants believe that the Office's delay in restricting the present application after more than 3 years after its filing date is prejudicial to the timely examination of the non-elected claimed inventions in a divisional application and also to the patent term of any patent resulting from a divisional application filed after the restriction. However, such prejudice will be avoided if the non-elected claimed inventions of Groups I, III and IV are examined in the present application, as the PTO delay in the untimely restriction will be taken into account in the patent term adjustment.

For at least the reasons mentioned above, Applicants pray for relief and reconsideration, and respectfully request the withdrawal of the Restriction Requirement for the concurrent examination of all inventions represented by Groups I, II, III and IV in the present application.

### **Amendment to the Claims**

- Claim 1 (of non-elected Group I) was amended to add the limitations of Claims 2 and 3, now canceled. This amendment is supported by at least original Claims 2, 3, 33, paragraphs [0031] on Page 8 and [0033] on Page 9 of the specification as filed.
- Claim 19 (of elected Group II) was amended to add the limitations of Claim 22, now canceled and to further add a forming step (d). This amendment is supported by at least original Claims 1 & 22, paragraphs [0031] on Page 8 and [0033] on Page 9 of the specification as filed.
- Claims 23 and 24 (of elected Group II) were amended for providing proper antecedent basis. This amendment is supported by at least paragraph [0018] on Pages 6-7 of the specification as filed.
- Claim 26 (of elected Group II) was amended for providing proper antecedent basis and changing step (d) to step (e), as a new forming step (d) was introduced into Claim 19 from which this claims depends.
- Claim 31 (of elected Group II) was amended to redirect such claim from Claim 28 to Claim 19.
- Claim 33 (of non-elected Group III) was amended to add the limitations of original Claims 34 and 38, now canceled, and to further add a forming step and a calcining step. This amendment is supported by at least original Claims 34, 38, paragraphs [0031] on Page 8 and [0033] on Page 9 of the specification as filed.
- Claim 44 (of non-elected Group III) was amended to redirect such claim from Claim 41 to Claim 33.

Applicants submit that no new matter is introduced by way of these claim amendments.

### **New Claims**

Applicants submit that no new matter is introduced by way of new claims and that each new claim is supported by the application as filed (where original claims, paragraph numbers and page numbers originate from the specification as filed), as follows:

- Claim 49 supported by at least original Claim 5, now canceled;
- Claims 50-53 supported by at least paragraph [0036] on Page 10 of the specification;
- Claim 54 supported by at least original Claim 16 (now canceled) and paragraph [0037] on Pages 10 & 11;
- Claim 55 supported by at least original Claim 17 (now canceled) and paragraph [0033] on Page 9;

- Claim 56 supported by at least original Claim 19, paragraphs [0016] on Page 6, [0033] on Page 9 and [0055] on Page 16;
- Claims 57 & 58 supported by at least paragraphs [0033] on Page 9 and [0055] on Page 16;
- Claims 59 & 60 supported by at least paragraph [0034] on Page 9;
- Claim 61 supported by at least original Claim 17 (now canceled) and paragraph [0033] on Page 9;
- Claim 62 supported by at least paragraphs [0031] on Page 8, [0033] on Page 9 and [0036] on Page 11;
- Claim 63 supported by at least paragraphs [0033] on Page 9 and [0055] on Page 16;
- Claim 64 supported by at least paragraphs [0033] on Page 9 and [0036] on Page 10;
- Claim 65 supported by at least original Claim 16 (now canceled) and paragraph [0037] on Pages 10 & 11;
- Claim 66 supported by at least original Claim 17 (now canceled);
- Claim 67 supported by at least original Claim 2 (now canceled);
- Claim 68 supported by at least paragraph [0055] on Page 16;
- Claim 69 supported by at least original Claim 3 (now canceled);
- Claim 70 supported by at least original Claims 20, 25, paragraphs [0033] on Page 9 and [0055] on Page 16;
- Claim 71 supported by at least original Claim 17 (now canceled) and paragraph [0033] on Page 9;
- Claim 72 supported by at least paragraphs [0033] on Page 9 and [0055] on Page 16;
- Claim 73 supported by at least paragraphs [0016] on Page 6 and [0032] on Page 9;
- Claim 74 supported by at least original Claim 16 (now canceled) and paragraph [0037] on Pages 10 & 11; and
- Claims 75 & 76 supported by at least paragraph [0055] on Page 16.

#### **Amendments to the Specification**

Paragraphs [0005], [0015], [0038] and [0058] of the specification as filed have been amended to correct obvious typographical and/or grammatical errors. No new matter was added by way of these amendments.

### **Supplemental Information Disclosure Statement**

A supplemental Information Disclosure Statement is filed herewith with additional relevant art. Applicants respectfully request that the attached documents be considered and be officially cited in the examination of this Application.

Under §1.97(b)(3), this supplemental Information Disclosure Statement shall be considered if filed before the mailing of a first Office Action on the merits. Accordingly, Applicants believe that no fee is due for the filing of this supplemental Information Disclosure Statement. Nonetheless, in the event that this supplemental Information Disclosure Statement cannot be considered under §1.97(b)(3), the Commissioner is authorized to charge Deposit Account Number 16-1575 in the amount of \$180 as required by §1.17(p), for this Information Disclosure Statement to be considered under §1.97(c).

### **Conclusion**

Applicants believe that they have fully responded to the Office Action dated April 6, 2007. Applicants further believe that no new matter was added by way of amendments to the specification, amendments to the claims, and addition of new claims.

Applicants respectfully request the withdrawal of the Restriction Requirement for the reasons stated above for the examination of all pending claims.

If resolution of any remaining issues pertaining to restriction groups and election may be facilitated by a telephone conference, or if the Examiner has any questions or comments or otherwise feels it would be advantageous, he is encouraged to telephone the undersigned at (281) 293-4751.

Applicants believe that this response is timely filed as it is filed within the 31-day shortened statutory deadline set forth in the Office Action dated April 6, 2007, and that no fee is due.

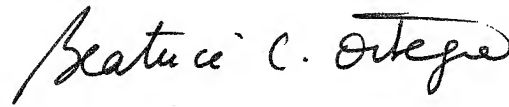
Applicants further believe that no additional claim fee is required as the result of this amendment because neither the total number of pending claims nor the number of pending independent claims is believed to exceed the total number (48) and the number of independent claims (5), respectively, for which fees have previously been paid. Indeed, the cancellation of 28 claims (i.e., Claims 2-17, 22, 34-35, 37-40, 42-43 & 46-48) in this Response is sufficient to cover the addition of 28 new claims (i.e., Claims 49-76) pending in the present application. Furthermore, the cancellation of two independent Claims 18 and 46 in this Response is sufficient to cover the addition of two new independent Claims 56 and 70.

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Response Dated April 27, 2007  
Reply to Office Action of April 6, 2007

If any required fee has been inadvertently omitted or any fee has been overpaid, or in the event that an extension of time is necessary in order for this submission to be considered timely filed, the Commissioner is authorized to please appropriately charge or credit those fees to **Deposit Account Number 16-1575** and consider this a petition for any necessary extension of time.

Respectfully submitted,

CONOCOPHILLIPS COMPANY - IP LEGAL



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